

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brand *et al.*
Application No. 10/517,135 Filed: February 17, 2006
US Patent No.: 7,560,425 Issued: July 14, 2009
TITLE A PHARMACEUTICAL COMPOSITION CONSISTING OF
RAPAMYCINE AND GASTRIN 17(LEU15) AND A METHOD FOR
TREATING DIABETES

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Petition under 37 C.F.R. § 1.183

In a decision dated June 15, 2010 (“Decision”), the United States Patent and Trademark Office (“USPTO”) denied the Patent Owner’s request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) on the apparent basis that the request was not properly signed in accordance with 37 § CFR 1.33(b). Applicants’ petition for reconsideration of the Decision under 37 C.F.R. § 1.183, which provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived, *inter alia*, on petition of the interested party.

The above-referenced patent issued July 14, 2009. The Patent Owner submitted its petition for patent term adjustment on September 10, 2009, requesting that the days of patent term adjustment be adjusted to 597 days from the twelve (12) days stated on the face of the patent. In other words, the Patent Owner has been deprived of more than one and one-half years of patent term. It therefore constitutes the precise situation contemplated by 37 CFR § 1.183.

For the reasons explained below, the USPTO erred in dismissing the Patent Owner's September 10, 2009 submission.

The September 10, 2009 submission was signed over a printed signature line reciting as follows:

David E. Johnson, Reg. No. 41,874
Attorney for Applicants
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY and POPEO, P.C.
Address all written correspondence to
Customer no.:30623
Tel: (617) 542-6000
Fax: (617) 542-2241

The signer wrote "For" in long-hand before "David E. Johnson" on the typed signature line. The signer additionally entered the number, 58,302, which is the registration number for Erica Carlson, a patent attorney then associated with Customer No. 30623.

The Patent Owner notes the statement in the April 12, 2010 Decision that the September 10, 2009 Request was not properly signed because it allegedly bore an illegible handwritten signature and registration number. 37 CFR § 1.4(d)(1) provides:

- (1) *Handwritten signature.* Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:
- (i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or
 - (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

The Patent Owner disputes the USPTO's assertion that the registration number provided by the signer was illegible. Viewed in its totality, it is readily apparent that the September 10, 2009 request for reconsideration complied with the requirements of 37 CFR §1.4(d)(1) because it

represented Ms. Carlson's original, handwritten, personally signed signature. Moreover, to the extent the USPTO disputes the signer's signature on the September 10, 2009 request for reconsideration, 37 CFR § 1.34 (the provision relied on by the USPTO in its April 12, 2010 decision) provides that the proper recourse for the USPTO should request additional information (emphasis added):

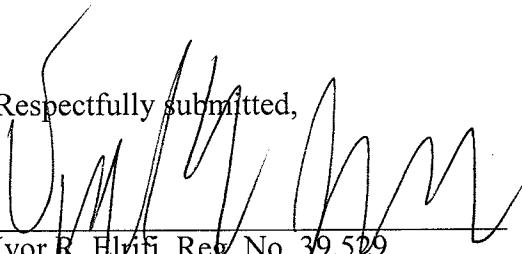
§ 1.34 Acting in a representative capacity.

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. **Further proof of authority to act in a representative capacity may be required.**

The Patent Owner will provide further proof of authority if such proof is requested by the USPTO. However, denying the opportunity to request further reconsideration will prevent the Patent Owner from addressing with the USPTO issues raised for the first time in the Decision. The Patent Owner therefore submits that it is in the best interests of the Patent Owner, the USPTO, and all parties concerned that the record and requests for reconsideration be as complete and thorough as reasonably possible.

This petition is filed within two months of the USPTO April 22, 2010 decision in the above-referenced matter. Applicants submit herewith payment in the amount of \$400.00 to cover the Petition fee in accordance with 37 CFR §1.17(f). The Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment of same, to Deposit Account No. 50-0311 (Reference No. 24492-510N01US).

Dated: June 22, 2010

Respectfully submitted,

Ivor R. Eliff, Reg. No. 39,519

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